



25 NOV 2002

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In re Application of
NEOGI
Serial No.: 10/018,817
PCT No.: PCT/US00/16761
Int. Filing Date: 16 June 2000
Priority Date: 16 June 1999
Atty Docket No.: 42637/GDL/N288
For: METHOD APPARATUS AND ARTICLE
OF MANUFACTURE FOR BRANDING A
DIAMOND WITH A FOCUSED ION
BEAM

DECISION ON PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to the applicant's "Petition Under 37 C.F.R. 1.47(b) and MPEP 409.03" filed 12 August 2002 to accept the application without the signature of inventor Jayant NEOGI.

BACKGROUND

On 16 June 2000, applicant filed international application PCT/US00/16761, which claimed priority of an earlier application filed 16 June 1999. A Demand for international preliminary examination, in which the United States was elected was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 December 2001.

On 17 December 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the International Search Report; an Information Disclosure Statement and a First Preliminary Amendment. An executed oath or declaration of the inventor as required by 35 U.S.C. 371 (c)(4) was not filed. 16 December 2001 being a Sunday, the papers were considered to be timely filed.

On 10 May 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$65.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the

earliest priority date. (37 CFR 1.492(e). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 12 August 2002, applicant responded with the present petition accompanied by a petition for a one-month extension of time and a check in the amount of \$195.00 (\$55.00 as payment of the one-month extension fee, \$65.00 as payment of the surcharge for providing an executed oath or declaration of the inventor later than thirty months from the earliest claimed priority date and \$130.00 as payment of the fee for the present petition). 10 August 2002 being a Saturday, with the filing of the petition for a one-month extension of time and payment of the extension fee, the papers filed 12 August 2002 are considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. A review of applicant's petition and accompanying exhibits finds that all items have been satisfied.

Regarding item (1), applicant has provided payment of the \$130.00 petition fee.

As to item (2), applicant has provided through the executed declaration of counsel sufficient evidence to show that the non-signing inventor, Mr. Neogi, has been provided with a complete set of the application papers and declaration document for execution and has not returned an executed version of said document.

Regarding item (3), applicant has provided the last known address of the non-signing inventor.

As to item (4), applicant has provided a declaration executed by Mr. John Bishop, on behalf of the corporate entity, Norsam and the non-signing inventor, Jayant Neogi.

Regarding item (5), applicant has provided copy of an executed assignment document from Mr. Neogi to Norsam Technologies for the present invention.

As to item (6), counsel has supplied the requisite statement that the present action is necessary to preserve the rights of the parties or to prevent irreparable damages.

As such, it is proper to grant applicant's petition under 37 CFR 1.47(b) at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **GRANTED**.

The application has an international filing date of **16 June 2000** and will be given a date of **12 August 2002** under 35 U.S.C 371(c).

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).



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Dear Mr. Neogi:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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